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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,073	09/27/2003	John R. Klug	1948/US/3	9290

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DORSEY & WHITNEY, LLP
INTELLECTUAL PROPERTY DEPARTMENT
370 SEVENTEENTH STREET
SUITE 4700
DENVER, CO 80202-5647

EXAMINER	
LAZARO, DAVID R	

ART UNIT	PAPER NUMBER
2155	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/673,073	KLUG, JOHN R.	
	Examiner	Art Unit	
	David Lazaro	2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 June 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *28-58 and 60-66* is/are pending in the application.

4a) Of the above claim(s) *45-58 and 60-66* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *28-44* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *27 September 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *See Continuation Sheet*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :3/9/04, 3/31/04, 9/13/04, 2/7/06.

DETAILED ACTION

1. Claims 1-27 and 59 are canceled.

2. Claims 45-55 are withdrawn by amendment.

3. Claims 56-58 and 60-66 are withdrawn from consideration based on applicant's election of group II. Please see the Election/Restriction section.

4. Claims 28-44 are examined on the merits.

Information Disclosure Statement

5. The information disclosure statements (IDS) submitted on 03/09/2004, 03/31/2004, 09/13/2004 and 02/07/2006 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements are being considered by the examiner.

Priority

6. This application claims the benefit of 60/452,369 filed 03/05/2003.

Drawings

7. The examiner accepts the drawings filed 09/27/03.

Election/Restrictions

8. Applicant's election of Group II, claims 28-44, in the reply filed on 06/26/2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

9. Furthermore, applicant amended non-elected group IV to depend on group II. As such, the examiner is updating the restriction to reflect that relationship between group II and group IV is now a species relationship, with claim 28 being a generic claim. However, group IV is still distinct from group II based on the rationale presented in the previous restriction requirement and the fact that applicant did not argue that the groups presented were not distinct. The burden still remains as the two groups are of separate classification and separate field of search.

10. As mentioned, claim 28 is generic. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP §809.02(a).

11. As applicant has elected claims 28-44 for examination, claims 56-58 and 60-66 (group IV) are withdrawn from consideration.

Double Patenting

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 28 and 43 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 13 and 14 of copending Application No. 11/425079 in view of U.S. Patent Application Publication 2002/0120705 by Schiavone. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following:

Claims 28 and 43 of the instant application essentially claim the same elements of claim 13 and 14 of the '079 application. Both sets of claims deal with determining if a communication is associated with a frank and processing the communication according to such a determination. The main differences between the two sets of claims are claims 28 and 43 of the instant application state the frank corresponds to a value and further corresponds to a class such that the processing rule is a class based rule.

However, Schiavone shows that a frank can correspond to a value and a class (Page 2 [0017] and [0012]: priority information can be indicative of a class and be associated with a value) such that the communication is processed according to a class based rule (Page 3 [0018] - message is handled based on class identified by priority - also see Page 4 [0030]).

As such, it would have been obvious to one of ordinary skill in the art to improve upon the claimed invention using the priority system of Schiavone for the predictable result of controlling distribution of communications based on priority information.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 101

14. Claim 44 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

15. Claim 44 states, "A computer-implemented software application which, when accessed, performs the method of claim 39." However, descriptions and expressions of a computer program not encoded on a computer readable medium do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized (See MPEP 2106.01). Therefore claim 39 is directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

17. Claims 28-31, 33, 34, 40, 42 and 43 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication 2002/0120705 by Schiavone et al. (Schiavone).

18. With respect to claim 28, Schiavone teaches a computer-implemented method for receiving and processing communications according to a value, comprising:

determining whether the communication is associated with a frank, the frank corresponding to a value (Page 2 [0017] - email is checked for priority information which may be in many forms and may have a value associated with it);

in response to determining the communication is not associated with a frank, processing the communication according to at least one default rule (Page 3 [0020]-[0021] - default priorities may be used or other information besides a specific priority indicator will be used for processing); otherwise

determining a class to which the frank corresponds (Page 2 [0017] and [0012]: priority information can be indicative of a class);

in response to determining the class to which the frank corresponds, processing the communication according to at least one class-based rule (Page 3 [0018] - message is handled based on class identified by priority - also see Page 4 [0030]).

19. With respect to claim 29, Schiavone further teaches wherein the step of processing the communication comprises: determining whether the frank corresponds to a class which is less than a specified minimum class; and in response to determining the frank corresponds to a class which is less than a specified minimum class, discarding the communication (Page 4 [0030] - lowest priority class of message may be rejected and not delivered).

20. With respect to claim 30, Schiavone further teaches the step of, in response to determining the frank corresponds to a class which is not less than a specified minimum class, transmitting the communication from a network node to a recipient system (Page 4 [0030] - classes of appropriate higher priority will be delievered).

21. With respect to claim 31, Schiavone further teaches where the communication is transmitted by way of at least one Internet service provider (Page 2 [0014] - ISP can carry out the invention).

22. With respect to claim 33, Schiavone further teaches wherein the step of processing the communication according to at least one class-based rule further comprises: determining whether the class is less than a specified minimum class; and in response to determining the class is less than a specified minimum service class, delaying delivery of the communication (Page 4 [0030] - delivery of lowest priority class of message may be delayed).

23. With respect to claim 34, Schiavone further teaches wherein the step of processing the communication according to at least one class-based rule comprises: determining whether the class is less than a specified minimum class; and in response to determining the class is less than a specified minimum class, placing the communication in a recipient-specified location (page 1 [0007] - routing to junk folder).

24. With respect to claim 40, Schiavone further teaches wherein the communication is an electronic mail (Page 2 [0012] email).

25. With respect to claim 42, Schiavone further teaches receiving a second communication; determining whether the second communication includes a second frank (Page 2 [0017] - would apply to all communications); in response to determining the second communication does include a second frank, determining a second class to which the frank corresponds (Page 2 [0017] and [0012]: each communication is checked for priority information); and determining a display order for the first and second communications, the display order based on the first class and the second class (Page 4 [0030] - recipient will receive mail in an order that is both determined based on the time of the incoming communication and the respective classes of the incoming communications).

26. Claim 43 is rejected based on the same logic of claim 28.

Claim Rejections - 35 USC § 103

27. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

28. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schiavone.

29. With respect to claim 32, Schiavone teaches all the limitations of claim 28, and further teaches that generally any type of rule can specify the processing for the message of any particular identified priority (Page 4 [0030]). Schiavone further teaches distinguishing between different levels of priority in terms of establishing a priority hierarchy and discarding communications based on differences in the priority levels (Page 4 [0030]).

Schiavone does not explicitly teach that if a frank is determined to be of a class that is greater than a minimal class, then the communication is discarded. However, one skilled in the art would readily recognize that a ranking scheme can be reversed and still carry out the same functionality. For example, it is common knowledge that one could rank levels from 1-10 with either 1 meaning the lowest or least important, 10 being the highest, or reverse it and have 1 meaning the highest or most important and 10 being the lowest. It is essentially a matter of perspective in how one chooses to label the levels. The corresponding functionality of the meaning attached to the corresponding label remains the same.

As such, it would have been obvious to one of ordinary skill in the art to substitute one ranking scheme for another for the predictable result of message processing based on the actual meaning of the ranking.

30. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schiavone in view of U.S. Patent 5,694,616 by Johnson et al. (Johnson).

31. With respect to claim 35, Schiavone teaches determining whether the frank corresponds to a class greater than or equal to a specified minimal class (Page 4 [0040]).

Schiavone does not explicitly disclose in response to determining the frank corresponds to a class greater than or equal to a specified minimum class, displaying at least a portion of the communication in a specified color. Johnson teaches that email messages that are determined to be of greater importance can be displayed in a specified color or with a particular icon (Col. 1 lines 34-42). This is done to reflect the important status of the message.

Thus, it would have been obvious to one of ordinary skill in the art to apply the technique of displaying a high priority message in a specified color as disclosed by Johnson to further improve the priority system of Schiavone for the predictable result of reflecting the higher priority of a particular message.

32. Claim 36-39 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schiavone in view of U.S. Patent 6,393,464 by Dieterman (Dieterman).

33. With respect to claim 36, Schiavone does not explicitly disclose determining whether a characteristic of a sender of the communication matches at least one entry on an approved list; and in response to determining the characteristic of the sender matches at least one entry on the approved list, ignoring the step of processing the communication according to at least one class-based rule.

Dieterman teaches determining if a characteristic of a sender of a communication matches information of an approved list (Col. 5 lines 24-35). If the sender is on the approved list, the message is delivered without any further processing. This allows for control of the delivery of electronic communications (Col. 3 lines 20-25).

Thus, it would have been obvious to one of ordinary skill in the art to apply the technique of determining if the characteristic of a sender matches at least one entry on an approved list as taught by Dieterman, to improve the messaging system of Schiavone for the predicable result of controlling delivery of electronic communications.

34. With respect to claim 37, Schiavone further teaches wherin the characteristic of the sender is one of an electronic mail address, a name, or an Internet protocol address (In Dieterman: Col. 3 lines 55-65).

35. With respect to claim 38, Schiavone teaches determining whether a characteristic of a sender of the communication matches at least one entry on an approved list; and in response to determining the characteristic of the sender matches at least one entry on the approved list, assigning a second class to the communication.

Dieterman teaches determining if a characteristic of a sender of a communication matches information of an approved list (Col. 5 lines 24-35). If the sender is on the approved list, the message is marked as not requiring approval. This allows for control of the delivery of electronic communications (Col. 3 lines 20-25).

Thus, it would have been obvious to one of ordinary skill in the art to apply the technique of determining if the characteristic of a sender matches at least one entry on an approved list as taught by Dieterman, to improve the messaging system of Schiavone for the predicable result of controlling delivery of electronic communications.

36. With respect to claim 39, Schiavone further teaches wherein the step of processing the communication according to at least one class-based rule comprises applying the class-based rule to the higher class of the class and the second class (In Schiavone Page 3 [0018]-[0020]: trusted sender priority is ranked the highest and considered first).

37. Claim 44 is rejected based on the same logic of claim 39.

38. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schiavone in view of U.S. Patent 6,301,608 by Rochkind (Rochkind).

39. With respect to claim 41, Schiavone further teaches the invention generally applies to network communications (Page 2 [0012]).

Schiavone does not explicitly disclose the communication is a telephone call.

Rochkind teaches a system that uses priority information to process communications (Col. 2 lines 28-33 and line 64 - Col. 3 line 16). Such communications includes telephone calls (Col. 3 line 56 - Col. 4 line 6).

Because both Schiavone and Rochkind process communications based on priority information, it would have been obvious to one skilled in the art to substitute telephone calls as a network communication in order to achieve the predictable result of processing communication based on the priority information of the communication.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lazaro whose telephone number is 571-272-3986. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

David Lazaro
October 29, 2007